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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,511	11/29/2001	Doron Cohen	IL920010047US1	4997
7590	12/27/2005		EXAMINER	
Stephen C. Kaufman Intellectual Property Law Dept. IBM Corporation P.O. Box 218 Yorktown Heights, NY 10598			NEURAUTER, GEORGE C	
			ART UNIT	PAPER NUMBER
			2143	
DATE MAILED: 12/27/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,511	COHEN ET AL.	
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 07 September 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-17 are currently presented and have been examined.

It is noted that a new Examiner has been assigned to this application. Any future correspondence regarding this application should be directed to the Examiner listed below.

Response to Arguments

Applicant's arguments filed 7 September 2005 have been fully considered but they are not persuasive.

The Applicant argues that Mathur does not teach or suggest at least indexing or searching documents that are located on the personal digital assistant (PDA) and any operation related to the transferring of the documents from the PDA and receiving the index from the intermediary. The Applicant also argues that Tripp fails to teach or suggest transfer of dynamic documents. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In view of the previous Examiner's rejections and motivations, the Examiner concurs with these findings.

The specification discloses:

"For purposes of clarity, documents time stamped after the last sync between intermediary 12 and PDA 14 are referred to herein as dynamic documents..." (paragraph 0028)

"The off-line intermediary may be a intermediary such as a desktop, a server, or a web server." (paragraph 0004)

It is noted that the specification does not provide any definition or description of an index, much less the narrower terms "static index" and "dynamic index" nor does the specification show any drawing that correspond to these elements. Therefore, the Examiner must interpret these limitations by their plain meaning as required by MPEP 2111.01. If the Applicant traverses the Examiner's finding, the Applicant is requested to show where these elements are sufficiently defined or described.

Mathur discloses creating a static index or "index information" including "words occurring within" a document and transferred the static index to a PDA as shown previously. Mathur does not disclose transferring dynamic documents from a PDA to an offline intermediary, however, as shown previously, Mathur suggests that a intermediary may transfer documents to the intermediary in

order for a static index to be created. Tripp discloses transferring dynamic documents from a computer to an offline intermediary for indexing or "The collected information is then transmitted to the cataloging computer. The transmitted collected information is then processed at the cataloging computer to generate a catalog of file references" which includes a "searchable catalog of object references". See also within Tripp a similar disclosure of this limitation (column 3, lines 20-52). Tripp expressly discloses that it is desirable to transfer dynamic documents to an offline intermediary for indexing because "As local storage for personal computers increases, the Find utility takes too long to retrieve the desired information..." and "incremental indexing is performed to lower the overhead on the desktop" (column 3, lines 39-41). In view of the disclosures of Tripp shown here and previously, Tripp clearly contemplates that transferring dynamic documents to an offline intermediary in order to offload a computer from performing text based searching. Therefore, this specific advantage as disclosed within Tripp would have motivated one of ordinary skill in the art to combine the teachings of these references and, since both references are directed to indexing words within the file and generating a static index of the file in order to send it back to a computer for processing, one of ordinary skill

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would have reasonably expected a successful combination of the teachings of references. Therefore, a proper finding of obviousness of the claimed invention has been found and the claims are not in condition for allowance.

Request for Information under 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR § 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The Examiner requests that the Applicant specifically identify prior art admitted in paragraph 0018 of the specification which "may allow for static indexes to be imported onto handheld devices".

The information is required to determine the relevancy of the prior art that the Applicant refers to in the specification is considered an essential part of the functionality of the claimed invention.

All individuals covered by 37 CFR 1.56 (reproduced in MPEP 2001.01) have a duty to disclose to the U.S. Patent and Trademark Office all material information they are aware of regardless of the source of or how they become aware of the information. See *Brasseler, U.S.A. I, L.P. v. Stryker Sales Corp.*, 267 F.3d 1370, 1383, 60 USPQ2d 1482, 1490 (Fed. Cir.

2001) ("Once an attorney, or an applicant has notice that information exists that appears material and questionable, that person cannot ignore that notice in an effort to avoid his or her duty to disclose."). Materiality controls whether information must be disclosed to the Office, not the circumstances under which or the source from which the information is obtained. If material, the information must be disclosed to the Office. The duty to disclose material information extends to information such individuals are aware of prior to or at the time of filing the application or become aware of during the prosecution thereof.

The Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment. See 37 CFR 1.105(c). It is also noted that the requirement for information extends from individuals identified under 37 CFR 1.56(c) or any assignee to the instant application. See 37 CFR 1.105(a) and 37 CFR 1.56(c) ("Individuals associated with the filing or prosecution of a patent application within the meaning of this section are: (1) Each inventor named in the application; (2) Each attorney or agent who prepares or prosecutes the application; and (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the

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assignee or with anyone to whom there is an obligation to assign the application.”)

The Examiner is authorized to require the submission of this information since the Examiner has determined that such information is relevant to the patentability of the claimed invention. See *Star Fruits S.N.C. v. United States* (Fed. Cir. 2005) (“So long as there is some legitimate reason for seeking the information under section 1.105, the applicant has a duty to respond...The Office is authorized under section 1.105 to require any information that is either relevant to patentability under any nonfrivolous legal theory, or is reasonably calculated to lead to such relevant information”).

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathur et al. (U.S. Patent Number 6,581,072), hereinafter referred to as Mathur, in view of Tripp et al. (U.S. Patent Number 6,516,337), hereinafter referred to as Tripp.

Regarding claim 1, Mathur disclosed a method for indexing dynamic documents on an off line intermediary [index server] and transfer the index to a personal digital assistant (PDA) (user computer system of varying types including a portable computer, a portable data assistant, etc.) (Figure 3, column 7 line 53-column 8 line 12, column 9 lines 49-62), the method comprises the steps of: creating off-line, from the dynamic documents, a static index (column 10 lines 13-26, lines 48-56); and transferring said off-line static index to said PDA (Figure 3, column 7 line 57-column 8 line 12, column 9 lines 49-62,).

Mathur taught the invention substantially as claimed. However, Mathur did not expressly teach transferring dynamic documents from the PDA to the off-line intermediary for indexing.

Mathur suggested exploration of art and/or provided a reason to modify the method with additional feature to include transferring dynamic documents from the PDA to the off-line intermediary for indexing (column 8 lines 21-38, column 10 lines 48-56, column 18 lines 1-12).

Tripp disclosed a method for transferring dynamic documents from the PDA [source computer] to the off-line intermediary [cataloging site] for indexing (column 2 lines 50-65, column 5 lines 36-65, column 6 lines 3-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Mathur with the teachings of Tripp to include transferring dynamic documents from the PDA to the off-line intermediary for indexing in order to allow indexing of local documents for faster retrieval (Tripp, column 3 lines 19-34) since as local storage for personal computers increases, the local utility takes too long to retrieve the desired information (Tripp, column 3 lines 19-34).

Regarding claim 2, Mathur disclosed a method wherein said intermediary is selected from the group consisting of a desktop, a server, and a web server (column 9 lines 49-62, column 7 lines 46-62, column 10 lines 13-26).

Regarding claim 3, Tripp disclosed a method further comprising the step of: updating said off-line static index with said dynamic documents that have been modified, added, or deleted after said step of creating, and from time to time, transferring said off-line updated static index to said PDA

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[local master index server] (Abstract, Figure 3, column 2 lines 50-65).

Regarding claim 4, Tripp disclosed a method wherein said from time to time is synchronization of said PDA [local master index server] with said off-line intermediary (column 1 lines 38-51, column 2 lines 50-65).

Regarding claim 5, Mathur and Tripp disclosed a method of claim 1 further comprising the step of: indexing on-line a dynamic index of said dynamic documents, said dynamic index stored on said PDA (column 9, lines 49-62 of Mathur) (column 3 lines 35-52, column 10 line 62-column 11 line 14 of Tripp).

Regarding claim 6, Mathur and Tripp combined disclose a method for searching text of data files stored on a personal digital assistant (PDA) (Mathur, Figure 3, column 6 lines 49-57, column 12 line 60-column 13 line 8), the method comprises the steps of: searching an on-line static index stored on said PDA and compiling therefrom static search results (Mathur, column 10 lines 13-26, lines 48-56); searching a dynamic index stored on said PDA and compiling therefrom dynamic search results (Tripp, Figure 5, column 3 lines 35-52); and merging said static search results with said dynamic search results (Tripp, Figures 3, 5, column 1 lines 38-51, column 2 lines 50-65).

Regarding claim 7, Mathur and Tripp combined disclose a method for indexing and searching text on a personal digital assistant (PDA) (Mathur, Figure 3, column 6 lines 49-57, column 12 line 60-column 13 line 8), the method comprises the steps of: creating off-line a static index of dynamic documents for transfer to said PDA (Mathur, column 10 lines 13-26, lines 48-56); and searching on said PDA, said static index and an on-line dynamic index, wherein said step of creating is independent from said of searching (Mathur, column 6 lines 49-57, column 12 line 60-column 13 line 8; Tripp, column 3 lines 35-52, column 6 lines 46-52).

Regarding claim 8, Mathur and Tripp combined disclose a method for indexing text on a personal digital assistant (PDA) (Figure 3, column 7 line 53-column 8 line 12, column 9 lines 49-62), the method comprises the steps of: creating on an off-line intermediary a static index (Mathur, column 10 lines 13-26, lines 48-56); transferring said static index from said intermediary to said PDA (Tripp, column 2 lines 50-65, column 5 lines 36-65, column 6 lines 3-17); from time to time, updating said off-line static index with dynamic text from said PDA (Tripp, Abstract, Figure 3, column 2 lines 50-65); and updating said static index stored on said PDA, with said updated off-line static index stored on

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said intermediary (Tripp, column 1 lines 38-51, column 2 lines 50-65).

Regarding claim 9, Mathur and Tripp combined disclose a method wherein said dynamic text is text on said PDA that has been added or modified after said step of creating (Mathur, column 9 lines 48-62, column 10 line 66-column 11 line 22; Tripp, column 1 lines 38-51, column 2 lines 50-65)

Regarding claim 10, Mathur and Tripp disclosed a method further comprising the step of: creating an on-line dynamic index from said dynamic text, said dynamic index stored on said PDA (column 9, lines 49-62 of Mathur) (column 3 lines 35-52 of Tripp).

Regarding claim 11, Tripp disclosed a method further comprising the steps of: detecting when the dynamic index exceeds predefined limits; and sending an update signal to said off-line intermediary (column 7 lines 20-35, column 11 lines 4-14, column 17 lines 38-46).

Regarding claim 12, Tripp disclosed a method wherein said signal comprising a warning to generate a new, merged static index (column 5 lines 62-65, column 9 lines 43-56).

Regarding claim 13, Tripp disclosed a method wherein said predefined limits are selected from the group consisting of predefined limits for search time, document capacity, or number

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of dynamic document (column 6 lines 46-52, column 7 lines 32-35).

Regarding claim 14, Mathur and Tripp disclosed a personal digital assistant (PDA) comprising: a plurality of data files ("documents"); an updatable static index (column 10 lines 56-column 11 line 22); and a dynamic index, wherein said updatable static index and said dynamic index enable search of said plurality of data files. (Tripp, column 2 lines 50-65, column 3 lines 35-52).

Regarding claim 15, Mathur disclosed a PDA wherein said updatable static index is created off-line on a intermediary (column 8 lines 48-62, column 10 lines-14-26, lines 48-56, column 10 line 66-column 11 line 4).

Regarding claim 16, Mathur and Tripp combined disclose a PDA further comprising: a search engine for searching text indexed in said static index (Mathur, column 8 lines 48-62, column 12 line 65-column 13 line 8, column 13 lines 22-29) and said dynamic index (Tripp, column 1 lines 52-60, column 3 lines 35-52).

Regarding claim 17, Tripp disclosed a PDA further comprising: an on-line indexer for creating said dynamic index (column 3 lines 35-52, column 8 line 60-column 9 line 10).

Conclusion

The prior art listed in the PTO-892 form included with this Office Action disclose methods, systems, and/or apparatuses similar to those claimed and recited in the specification.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

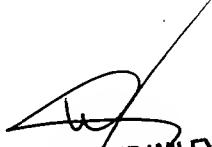
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn


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TECHNOLOGY CENTER 2100